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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,950	12/21/2001	Hanns Misiak	ICC-235	7673

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LOCTITE CORPORATION
Legal Department
1001 Trout Brook Crossing
Rocky Hill, CT 06067

EXAMINER

YOON, TAE H

ART UNIT PAPER NUMBER

1714

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,950

Applicant(s)

MISIAK, HANNS

Examiner

Tae H Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001 and 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 25-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 25-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The amended claims 3-23 in the Supplemental Preliminary Amendment filed on January 31, 2002 has not been entered since Preliminary Amendment had cancelled claims 3-24 and since the cancelled claims cannot be replaced with the same claim numbers. Thus, claims 1 and 2 and new claims 25-45 are examined.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2 and 25-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification and claims recite tributyl-O-acetyl citrate and triethyl-O-acetyl citrate, but said esters do not contain any aromatic moiety and thus compounds with "O" are not possible. Applicant failed to teach how to obtain such compounds adequately.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2 and 25-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Improper Markush language is recited in claim 1 and an insertion of "and" is needed before "2-(2'-methoxy)-ethoxy butyl-cyanoacrylate. Spelling correction of "trimellit(h)ate" is needed in claim 2. The recited tributyl-O-acetyl citrate and triethyl-O-acetyl citrate are confusing and incorrect since said esters do not contain any aromatic moiety and thus compounds with "O" are not possible.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 25-27, 29, 30, 32-37, 39-41, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al (US 5,998,472).

Berger et al teach mixed cyanoacrylate ester compositions in example 1. The instant invention further recites the use of ethyl cyanoacrylate and a plasticizer. However, Berger et al teach employing C₁ to C₈ cyanoacrylate in claim 1. Even though Berger et al teach that the use of a plasticizer is not preferred, a reference must be considered for all that is disclosed and must not be limited to preferred embodiments or

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working examples, *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972). Various plasticizers are taught at col. 6, lines 26-45.

It would have been obvious to one of ordinary skill in the art at the time of invention to utilize ethyl cyanoacrylate in said example 1 instead of butyl cyanoacrylate with a plasticizer since choosing a specie (ethyl cyanoacrylate) from species (C_1 to C_8 cyanoacrylate) is a *prima facie* obviousness and since the invention of the prior art must not be limited to preferred embodiments or working examples absent showing otherwise.

Claims 1, 2, 25, 26, 32-36 and 39-45 are rejected under 35 U.S.C. 102(b) as anticipated by Kimura et al (US 4,364,876).

Kimura et al teach adhesive compositions comprising a 2-cyanoacrylate formula (I) and a 2-cyanoacrylate formula (II) at cols.1 and 2 and in example 9 wherein a mixture of ethyl cyanoacrylate and 2-(2'-ethoxy)-ethoxyethyl-2''- cyanoacrylate is seen. The use of a plasticizer and various amounts of the formula (I) and the formula (II) are taught at col. 5, lines 17-23 and 47-59. The use of the compositions in bonding and coating is taught in abstract. Thus, the instant invention lacks novelty.

Claims 1, 2, 25-30, 32-36 and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al (US 4,364,876) in view of Joyner et al (US 2,784,127), Berger et al (US 5,998,472), Malofsky et al (US 6,512,023), Hickey et al (US 2002/0156203) and Hoganson et al (US 2003/0074049).


The instant invention further recites other plasticizers. However, such plasticizers are well known in the art as taught by Joyner et al (col. 3, lines 7-35), Berger et al (col. 6, lines 26-45), Malofsky et al (col. 15, lines 1-10), Hickey et al ([0048]) and Hoganson et al (table 3).

It would have been obvious to one of ordinary skill in the art at the time of invention to utilize the art well known plasticizers taught by Joyner et al, Berger et al, Malofsky et al, Hickey et al or Hoganson et al in Kimura et al since Kimura et al teach employing ester plasticizers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/March 8, 2004